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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,918

04/24/2006

Tor Kihlberg

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7484

36335

7590

05/21/2008

GE HEALTHCARE, INC.

IP DEPARTMENT

101 CARNEGIE CENTER

PRINCETON, NJ 08540-6231

EXAMINER

KUMAR, SHAIENDRA

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/576,918	<b>Applicant(s)</b> KIHLEBERG ET AL.	
	<b>Examiner</b> SHAIENDRA -. KUMAR	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 8-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

This office action is in response to applicants' communication filed on 2/14/08.

Claims 1-17 are pending in this application. Claims 8-17 stand withdrawn from the consideration, being drawn to the non elected invention. The restriction requirement is made FINAL.

Rejection of claims 1-7 under 35 USC 102(e) is hereby withdrawn, subsequent to applicants' arguments.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over combined teachings of Kihlberg et al and Rahman et al (J. Org. Chem., 2003).

Applicants' claim a method for labeling synthesis comprising: (a) a UV reactor assembly (b) a reagent to be labeled (c) a carbon-isotope monoxide enriched gas-mixture (d) introducing at high pressure said reagent into the reaction chamber (e) UV lamp (f) removing the labeled product from the reaction chamber, and a concave mirror.

Further, the claims embody a method of producing the carbon-isotope monoxide enriched gas-mixture from carbon-isotope dioxide.

Kihlberg et al disclose a method and apparatus for production and use of  $^{11}\text{C}$  carbon monoxide in labeling synthesis (please see, abstract, and pages 4 and 5 also see the whole document). Kihlberg also discloses a method of producing  $^{11}\text{C}$  carbon monoxide enriched gas-mixture from carbon-isotope dioxide. Further, Kihlberg teaches the utilization of carbon-isotope dioxide in the labeling synthesis to produce  $^{11}\text{C}$  carbon monoxide enriched gas-mixture in a reaction chamber as embodied in the instant claims. The difference between the reference and herein claimed process is the lack of UV lamp and the concave mirror.

Rahman et al is teaching that in the synthesis of  $^{11}\text{C}$  amide using the  $^{11}\text{C}$  carbon monoxide, use of UV lamp is old in the art, see pages 3559-3560.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Kihlberg et al, by including the UV lamp in the system for labeling as taught by Rahman et al, because the latter reference is expressly teaching that in the synthesis of  $^{11}\text{C}$  labeling, use of UV lamp is old in the art, with the reasonable expectation of achieving a successful labeling, absent evidence to the contrary. With reference to the concave mirror, applicants have not provide its utility, and it seems that the sole purpose of the mirror is to see if the reaction is complete, absent evidence to the contrary.

Applicants' arguments are moot in view of the new ground of rejection.

***Double Patenting***

5. Claims 1-7 are again provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 11/268,107, for the reasons of record. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the instant application expressly overlap the process of labeling by the above patent application, and it would have been prima facie obvious to use the process of the above patent application for labeling, with the reasonable expectation of achieving labeling, absent evidence to the contrary. Applicants' remarks are moot in view of the new ground of rejection, and ODP rejection is appropriate in the present case.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6 .Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA -. KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (571)272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHAIENDRA - KUMAR/  
Primary Examiner, Art Unit 1621

S.Kumar  
5/19/08